

Application No.: 09/846,645

Docket No.: 10004560-1

**REMARKS****I. Introduction****The Final Action:**

Rejects claims 1 and 5 – 8 under 35 U.S.C. § 102(e);

Rejects claim 13 under 35 U.S.C. § 112; and

Rejects claims 2 – 13, 9 – 15, and 17 under 35 U.S.C. § 103(a).

Claims 1 – 20 remain pending in the present application and the Applicants respectfully ask the Examiner to withdraw the outstanding rejections in light of the following remarks.

**II. Improper Finality**

The Applicants respectfully remind the Examiner that a second Action on the merits should not be made Final when the Examiner introduces a new ground of rejection not necessitated by amendment, whether or not the art reference is already of record. See M.P.E.P. § 706.07(a). In the Final Action, Claim 6 is rejected under 35 U.S.C. § 102(e) and claim 13 is rejected under 35 U.S.C. § 103(a). Neither of these rejections appear in the Examiner's Previous Action, and neither were necessitated by an amendment. The Applicants, therefore, respectfully assert that the rejections of claims 6 and 13 are new grounds for rejection, and that finality of the Final Action is improper. The Applicants respectfully ask the Examiner to withdraw that finality.

**III. Improper Assumption**

At page 3, paragraph 4, the Examiner states "it is first noted that the Applicant has admitted that the claim language of the various claims is not patentably different in reply the restriction of paper number 4 [sic]." A review of paper number 4 (Applicants' response, with traverse, to the Examiner's restriction requirement) will show that the Applicants have made no such admission. On page 1 of paper number 4, the Applicants demonstrated that the restriction requirement failed to provide reasons and examples of why the proposed groups were independent and distinct, and was therefore deficient. The Applicants respectfully remind the Examiner that M.P.E.P. § 803 places the burden on the Examiner to provide these

Application No.: 09/846,645

Docket No.: 10004560-1

reasons and examples in order to require restriction. The Applicants respectfully assert that they have made no admissions at all with respect to the patentable distinctiveness of any claims or groups of claims, whether selected in response to the restriction requirement or not. The Applicants' remarks in paper number 4 merely demonstrate that the Examiner did not meet the required burden.

#### **IV. Rejections under 35 U.S.C. § 112, First Paragraph**

The Final Action rejects claim 13 as failing to comply with the enablement requirement of 35 U.S.C. § 112. However, the Applicants respectfully remind the Examiner, again, that M.P.E.P. § 2106.02 requires the Examiner to lay out a factual analysis of why the Examiner feels the disclosure is inadequate. The Applicants respectfully submit that the Examiner's mere conclusion that he finds the disclosure inadequate does not provide the framework required for a reasonable discussion. The Applicants also remind the Examiner that the description of a software element's function is considered adequate for enablement under M.P.E.P. § 2106.01, because one of ordinary skill in the art is capable of writing code to fulfill that function. The Applicants respectfully submit that pages 7 and 8 clearly describe the function of the application program interface described in claim 13, and respectfully ask the Examiner to withdraw the rejection.

#### **V. Rejections Under 102(e)**

The Applicants respectfully assert that neither the Previous Action nor the Final Action has met the dictates of the M.P.E.P. in rejecting the pending claims.

In order to properly reject claim 1 under 35 U.S.C. § 102(e), the Examiner is required by §§ 2112 and 2131 of the M.P.E.P. to demonstrate that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 quoting *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628,631 (Fed. Cir. 1987). It is therefore incumbent upon the Examiner to specifically address each of the rejected claim's limitations.

Claim 1 includes the following:

Application No.: 09/846,645

Docket No.: 10004560-1

retrieving device information from a device associated with said I/O path  
utilizing a device control protocol;  
retrieving a property file defining a type of device;  
executing code associated with said property file, wherein said code is  
operable to determine whether said device is said type of device utilizing in part said  
retrieved device information.

The Applicants respectfully assert that neither the Previous nor the Final Action has shown that *Babu* teaches all of these limitations. Specifically, both Actions fail to demonstrate, and a review by the Applicants' attorney has failed to locate, where *Babu* teaches "retrieving a property file defining a type of device," and where *Babu* teaches, "executing code associated with said property file." Because *Babu* fails to teach these limitations, *Babu* cannot anticipate claim 1.

In the Final Action, the Examiner asks "how the obtaining of a device identifier is not a method of determining the type of device." The Applicants respectfully respond in two parts First, whether or not *Babu* and claim 1 describe methods that purport to accomplish the same goal is not dispositive. The method of claim 1 and the method of *Babu* accomplish their respective goals using different limitations, therefore, claim 1 includes limitations not taught by *Babu*, and *Babu* does not anticipate claim 1.

Second, the Applicants respectfully submit that the burden initially lies with the Examiner to demonstrate why obtaining a device identifier is the same as determining the type of device, not with the Applicants to prove that they are different. However, even if they are deemed the same, the logic leading the Examiner to the conclusion that *Babu* anticipates claim 1 is flawed. The Applicants demonstrated this in their Previous Response. Specifically, if the steps cited by the Examiner as anticipatory of claim 1 are followed (namely those found in column 2, line 5 through column 3, line 10), then the goal of these steps cannot be to determine a device type. For if it is assumed that the Examiner's original premise is true, namely that obtaining a device type identifier is in fact the same as determining the type of device (as Examiner has argued so vociferously in both the Previous Action and the Final Action), then the device type is identified by *Babu* in the very first step of that process (*Babu* column 2, line 64, step "(A)" in a summary of the *Babu* process cited by the Examiner).

Application No.: 09/846,645

Docket No.: 10004560-1

Therefore, it is illogical to conclude that the remaining steps are used for the purpose of accomplishing a task already completed.

The Examiner responded to this argument in the Final Action by asking the Applicants for a cite to support their assumption, and by stating that "it is irrelevant whether the device type is known previous to the determination of the type of device." In response, the Applicants respectfully remind the Examiner that the assumption for which the Examiner seeks support (that obtaining the device type identifier is the same as determining the device type) is the Examiner's own assumption. The Applicants do not now claim (and did not in the Previous Response) that this statement is true, but rather have used the Examiner's own premise to demonstrate the flaw in the logic of the rejection.

Further, the Applicants respectfully assert that it is absolutely relevant whether or not the device type is known before or after the steps taken by *Babu* are performed. For in order to be anticipatory, M.P.E.P. § 2131 requires *Babu* arrange the elements of claim 1 as required by claim 1. *Babu* cannot meet this requirement, because *Babu* does not retrieve a property file and use it to determine the type of device in use.

The Applicants respectfully submit, therefore, that the rejection of record fails to demonstrate that *Babu* teaches each and every limitation of claim 1, that it fails to arrange the limitations it does teach in the manner proscribed by claim 1, and what limitations it does teach cannot logically be intended to perform the same task as those of claim 1. The Applicants respectfully ask the Examiner to withdraw the rejection.

Claims 5 – 8 depend either directly or indirectly from claim 1, and inherit all of that claim's limitations. Therefore, claims 5 – 8 inherit limitations not taught by *Babu*, and the Applicants respectfully ask the Examiner to withdraw the previous rejections to claims 5, 7, and 8, and the new rejection of claim 6.

#### **VI. Rejections Under 35 U.S.C. § 103(a)**

The Final Action repeats the Previous Action's rejections regarding claims 2-4, 9-12, and 14-20, and lists its new rejection of claim 13. Without conceding that the other requirements of M.P.E.P. § 2143 have been met, the Applicants respectfully submit that the

Application No.: 09/846,645

Docket No.: 10004560-1

Final Action has again failed to demonstrate that the cited references teach or suggest all the claim limitations in the rejected claims.

For Example, the Office Action rejects claims 2 and 3 as unpatentable over *Babu* alone, and rejects claim 4 as unpatentable over *Babu* in light of *Allen et al.*, published US Patent Application No. 2002/0161852 (hereinafter *Allen*). But as dependants of claim 1, claims 2 – 4 inherit all of that claim's limitations. As stated above, *Babu* does not teach all of the elements of claim 1, thus *Babu* does not teach every element of claims 2 – 4. As the rejections of claims 2 and 3 rely on *Babu* alone, the Applicants respectfully request that the Examiner withdraw those rejections. Further, because *Allen* does not appear to teach the absent limitations either, the Applicants also respectfully ask the Examiner to withdraw the rejection of claim 4.

The Final Action also repeats the Previous Action's rejection of claim 9, stating that claim 9 is unpatentable over *Babu* alone. Claim 9 recites a system that includes "code for calling a method of each instantiated object, wherein said method is operable to determine whether a device associated with said I/O path is the type of device defined by said data structure associated with said respective instantiated object of said method." Neither Action has identified which aspect of *Babu* the Examiner feels teaches this limitation, and the Applicants' attorney could not identify a passage in *Babu* that does teach such code. Within the range cited by the Examiner at column 3, lines 8 – 10, *Babu* does "[look] up the device type identifier in a device type table stored in the database." However, to perform this step the system of *Babu* must already know what type the device is, because this appears to be the very information the system uses to look up the device type identifier. These steps, therefore, cannot be "operable to determine whether a device associated with said I/O path is the type of device defined by said data structure," because when *Babu* looks up the device type identifier, *Babu* has already determined the device type. *Babu* does not, therefore, teach every element of claim 9, and the Applicants respectfully ask the Examiner to withdraw the rejection.

Claims 10-13 depend directly or indirectly from claim 9, and thus inherit all of the limitations of claim 9. Because claims 10-13 each contain limitations not disclosed by *Babu*,

Application No.: 09/846,645

Docket No.: 10004560-1

the Applicants respectfully submit that claims 10-13 are patentable over *Babu*, and respectfully ask the Examiner to withdraw the rejection.

The Final Action also repeats the Previous Action's rejection of claim 14 as unpatentable over *Babu* alone. But as the Previous response demonstrated, *Babu* does not teach a method for discovering a type of device that includes the step of "calling a method of each created object, wherein said method is operable to determine whether a device associated with said I/O path is the type of device described by the property file associated with the said object method." Again, neither Action has identified which aspect of *Babu* the Examiner feels teaches this limitation. If the Examiner is relying upon the step where *Babu* "[looks] up the device type identifier in a device type table stored in the database," the Applicants respectfully remind the Examiner that this step does not determine whether the device is the type of device described by the property file. As argued above, it is illogical to claim that this step is performed to identify the device type, because the device type is the very information *Babu* is using to obtain the device type identifier. *Babu* does not, therefore, teach every element of claim 14, and the Applicants respectfully ask the Examiner to withdraw the rejection.

The Final Action also repeats the rejection of claims 15 and 17 as unpatentable over *Babu* alone, and claim 16 as unpatentable over *Babu* in light of *Allen*. However, as dependants of claim 14, claims 15-17 inherit all of the limitations of claim 14, and *Babu* does not teach all of the elements of claim 14. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejection of claims 15 and 17. Further, because *Allen* does not appear to teach the absent limitations either, the Applicants also respectfully ask the Examiner to withdraw the rejection of claim 16.

The Final Action rejects claim 18 as unpatentable over *Babu* in light of *Allen*. Claim 18 recites a system for analyzing input/output paths that includes:

a management server process, wherein said management server process is operable to receive gathered device information from said plurality of host agent processes and from said SNMP manager process; and wherein said management server process is operable to call code identified by property files with gathered

Application No.: 09/846,645

Docket No.: 10004560-1

device information as arguments to thereby identify types of devices associated with I/O paths of said SAN.

Neither Action identifies which aspect of *Babu* the Examiner feels teaches this limitation. At column 3, lines 47 – 49, *Babu* does purport to send “an SNMP Query For a system object identifier to the network...and [test] whether the device is discovered in the network,” but it is not logical to interpret this step as identifying types of devices. The type of device appears to be the very information of *Babu* sends to the network. *Allen* does not appear to teach this element either, and indeed, the Office Action does not rely on it to do so. The combination of *Babu* and *Allen* do not, therefore, teach every element of claim 18, and the Applicants respectfully ask the Examiner to withdraw the rejection.

Claims 19 and 20 depend directly or indirectly from claim 18, and thus inherit all of the limitations of claim 18. Because claims 19 and 20 contain limitations not disclosed by *Babu* and *Allen*, the Applicants respectfully submit that claims 19 and 20 are patentable over *Babu* and *Allen*, and respectfully ask the Examiner to withdraw the rejection.

Although the motivation for combining the cited references has not been addressed, the Applicants do not concede that any of the combinations used in the Final Action are proper. The Applicants merely contend that the Examiner has yet make a prima facie case for rejecting any of the claims rejected under 35 U.S.C. § 103(a), and that any specific arguments regarding motivation would be premature.

In the rejections of claims 2 – 4, 9 – 12, and 14 – 20, the Final Action repeats that various elements of the rejected claims are well known in the art and has provided several references in support of these contentions. The Applicants have not specifically addressed these issues, because the Examiner has not as yet made a prima facie showing of obviousness. The Applicants reserve the right to contest these issues in subsequent papers.

Application No.: 09/846,645

Docket No.: 10004560-1

**VII. Conclusion**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10004560-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482735948US, in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: March 26, 2004

Typed Name: Carrie Wilson

Signature: 

Respectfully submitted,

By 

Michael A. Papalas

Attorney/Agent for Applicant(s)

Reg. No.: 40,381

Date: March 26, 2004

Telephone No. (214) 855-8186